

REMARKS

Claims 1-5, 8, 10-17, 23, and 25-28 are under examination in the present case. Each of these claims is rejected under 35 U.S.C. § 112, first paragraph. The rejections are addressed below.

Support for the amendments

Support for the claim amendments is found throughout the specification. For example, support for the amendment of claims 1-5, 10, 11, 14, 15, 23, and 25, which now recite "*C. elegans*, isolated *C. elegans* cell," or "*C. elegans DAF-18 gene*," is found at pages 108-112 and at Figures 40A and 40B of applicants' specification. Support for the amendment of claims 2-4, 12, 13-15, and 23, which now recite "human PTEN" is found at pages 108-110 and at Figure 39B.

As an initial matter, applicants note that they disagree with the present rejections, but, in order to expedite prosecution, applicants have amended the pending claims. Applicants reserve the right to pursue all canceled subject matter in this, or future, related applications.

Rejections under 35 U.S.C. § 112, first paragraph

Written description

Claims 1-5, 12-15, and 23 are rejected, under 35 U.S.C. § 112, first paragraph, as lacking an adequate written description for failing to disclose any nematode *daf-18* gene other than *C. elegans daf-18* and any mammalian PTEN gene other than human PTEN.

Amended claim 1 and its dependent claims now recite "a *C. elegans daf-18* gene." Amended claim 2 and its dependent claims now recite "a human PTEN gene." Amended claims 10 and 11 and their dependent claims now recite *C. elegans* DAF-18-mediated lipid phosphatase activity. Amended claims 12 and 13 and their dependent claims now recite human PTEN-mediated lipid phosphatase activity. Amended claim 23 and its dependent claims now recite "a transgenic *C. elegans* whose cells contain a transgene encoding a human PTEN polypeptide."

As applied to these amended claims, the written description rejection should be withdrawn.

Enablement

Claims 1-5, 8, and 10-17 are further rejected, under 35 U.S.C. § 112, first paragraph, as lacking enablement, based on the assertion that applicants have failed to enable methods for identifying a compound that modulates any nematode *daf-18* gene other than *C. elegans daf-18*, or any mammalian PTEN gene other than human PTEN in any nematode other than *C. elegans*.

Claims 8, 16, and 17 have been cancelled, and claims 1, 2, and their dependent claims now recite "contacting the *C. elegans*, isolated *C. elegans* cell, or isolated mammalian cell with a candidate compound" and determining the effect of the compound on "*daf-18* expression or activity [claim 1]" or "human PTEN [claim 2] expression or activity." Claims 10 and 11 and their dependent claims now recite "*C. elegans DAF-18-*

mediated lipid phosphatase activity;” and claims 12 and 13 and their dependent claims now recite “human PTEN-mediated lipid phosphatase activity.”

Claims 23 and 25-28 are rejected as lacking enablement for failing to teach how to make and use any transgenic nematode other than *C. elegans* containing a transgene encoding any mammalian PTEN polypeptide other than human PTEN.

Claims 27 and 28 have been cancelled, and claim 23 and its dependent claims now recite “a transgenic *C. elegans* whose cells contain a transgene encoding a human PTEN polypeptide.”

As applied to these amended claims, the enablement rejection should be withdrawn.

Information Disclosure Statement

Applicant's note that the form PTO 1449, filed on March 5, 2003, was not returned with the last Office Action. Applicants hereby request that this statement be initialed and returned with the next Office communication.

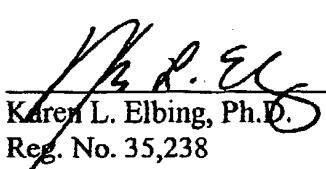
CONCLUSION

Applicants submit that this case is in condition for allowance, and such action is respectfully requested. If the Office does not concur, a telephonic interview with the undersigned is hereby requested.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 24 Apr. 1 2003


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